



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/597,920	06/19/2000	Lawrence E. Samelson	NIH-05065	4586

21874 7590 06/04/2003
EDWARDS & ANGELL, LLP
P.O. BOX 9169
BOSTON, MA 02209

EXAMINER

HELMS, LARRY RONALD

ART UNIT	PAPER NUMBER
----------	--------------

1642

DATE MAILED: 06/04/2003

RC

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/597,920

Applicant(s)

SAMELSON ET AL.

Examiner

Larry R. Helms

Art Unit

1642

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 61-84 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 61-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Request for Continued Examination

1. The request filed on 4/2/03 for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/597,920 is acceptable and a RCE has been established. Claims 61-84 are pending and are currently under prosecution. An action on the RCE follows.
2. Claims 4-6, 29, 33, 37-60 have been cancelled.
Claims 61-84 have been added.
3. Claims 61-84 are under examination.
4. The text of those sections of Title 35 U.S.C. code not included in this office action can be found in a prior Office Action.
5. The following Office Action contains some NEW GROUNDS of rejection .

Rejections Withdrawn

6. The rejection of claim 38 under 35 U.S.C. 112, first paragraph, is withdrawn.
7. The rejection of claims 39-44 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the amendments to the claims

Art Unit: 1642

Response to Arguments/ NEW GROUNDS of rejection

8. The rejection of newly added claims 73-77, 79-82, 84 under 35 U.S.C. 102(b) as being anticipated by Buday et al (The Journal of Biological Chemistry 269:9019-9023, 1994, IDS #5) and as evidenced from the specification is maintained.

The response filed 4/2/03 has been carefully considered but is deemed not to be persuasive. The response states that with respect to claims 70-84, Buday's antibody is not generated against a portion of LAT comprising at least about five amino acids and this element must be given weight because the way the antibodies are made does impact the structural properties and the antibody of Buday does not recognize at least 5 amino acids of LAT of SEQ ID NO:4 (see page 7-8 of response). In response to this argument, Buday's antibody would be specific for SEQ ID NO:4. This is explained as follows, because the claims recite that the antibody is generated against a polypeptide comprising any 5 or 20 or residues 31-233 of SEQ ID NO:4 the antibody of Buday would recognize the phosphotyrosine in SEQ ID NO:4 which can be generated against the entire protein (comprising) or any residues that contain the phosphotyrosine residue. If the entire protein was used as an immunogen or any fragment that has the phosphotyrosine residue, antibodies can be generated that bind the phosphotyrosine residue, such as Buday's. Thus, the art reads on the claims.

9. The rejection of newly added claims 73-78, 80-83 under 35 U.S.C. 102(e) as being anticipated by Hirth et al (U.S. Patent 5,958,959, filed 6/1/95) is maintained.

Art Unit: 1642

The response filed 4/2/03 has been carefully considered but is deemed not to be persuasive. The response states that with respect to claims 70-84, Hirth's antibody is not generated against a portion of LAT comprising at least about five amino acids (see page 8 of response). In response to this argument, Hirth's antibody would be specific for SEQ ID NO:4. This is explained as follows, because the claims recite that the antibody is generated against a polypeptide comprising any 5 or 20 or residues 31-233 of SEQ ID NO:4 the antibody of Hirth would recognize the phosphotyrosine in SEQ ID NO:4 which can be generated against the entire protein (comprising) or any residues that contain the phosphotyrosine residue. If the entire protein was used as an immunogen or any fragment that has the phosphotyrosine residue, antibodies can be generated that bind the phosphotyrosine residue, such as Hirth's. Thus, the art reads on the claims.

Claim Rejections - 35 USC § 112

10. Claims 61-72 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 61 and 67 have been amended to recite "does not cross-react with other non-LAT ZAP 70 or non-LAT Syk substrates". The response filed 4/2/03 states that support for the limitation can be found at page 38, lines 9-12. The response filed 4/2/03

Art Unit: 1642

has been carefully considered but is deemed not to be persuasive. The specification at the cited location states "the specificity of a LAT fragment for specific binding agents is confirmed by ensuring non-crossreactivity with other ZAP-70 and/or Syk substrates". The specification does not support antibodies that do not cross react with "non-LAT ZAP 70" or "non-LAT Syk substrates" because the specification at the recited page and lines is directed to fragments that have a certain specificity by confirming non crossreactivity to other ZAP-70 and Syk substrates and Lat fragments capable of eliciting antibodies capable of distinguishing LAT from LAT homologs. The specification at the cited place is not directed to antibodies that do not crossreact to non-LAT ZAP 70 or non-LAT Syk substrates. Applicant is required to provide specific support in the application as originally filed or remove the limitation from the claims.

11. Claims 74-77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 74-77 are indefinite for reciting for example in claim 74 "polypeptide comprising at least five amino acids comprises at least about 20 amino acids" because it is not clear if the polypeptide comprises 5 or 20 amino acids. In addition, claim 75 is indefinite for reciting "comprises at least about five amino acids comprises SEQ ID NO:4" because it is not clear if this claim is further limiting claim 73. claim 76 and 77

are indefinite because again it is unclear if the polypeptide has 5 or 20 residues because of claim 74's indefinite nature.

Conclusion

12. No claim is allowed.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry R. Helms, Ph.D, whose telephone number is (703) 306-5879. The examiner can normally be reached on Monday through Friday from 7:00

Art Unit: 1642

am to 4:30 pm, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

15. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 308-4242.

Respectfully,

Larry R. Helms Ph.D.

703-306-5879

A handwritten signature in black ink, appearing to be 'L. Helms', written over a horizontal line.